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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  60469-194; PA000.05025-US
<b>CERTIFICATE OF FACSIMILE</b> I hereby certify that this Pre-Appeal Brief Request For Review and Notice of Appeal are being facsimile transmitted to (571) 273-8300. on <u>4-9-09</u> Signature <u>Theresa M. Palmateer</u> Typed or printed name <u>Theresa M. Palmateer</u>		Application Number  10/522,191  Filed  01/25/2005
		First Named Inventor  Hugh James O'Donnell  Art Unit  1794
		Examiner  Gray, Jill M.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

attorney or agent of record.  
Registration number 37,139



Signature

David J. Gaskey

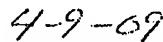
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Registration number if acting under 37 CFR 1.34



Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.



\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PA-000.05025-USIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Hugh James O'Donnell  
Serial Number: 10/522,191  
Filed: 01/25/2005  
Group Art Unit: 1794  
Examiner: Gray, Jill M.  
Title: ELEVATOR BELT ASSEMBLY WITH  
PRESTRETCHED SYNTHETIC CORDS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This paper is responsive to the Final Office Action mailed on January 9, 2009. Applicant hereby requests Pre-Appeal Brief Review because there is no *prima facie* case of anticipation or obviousness against any of Applicant's claims.

**The rejection of claims 1, 5, 7-8, 10 and 13-16  
under 35 U.S.C. §102(e) as being anticipated  
by U.S. 2003/0092524 (the *Baranda, et al.* reference)  
must be withdrawn.**

Applicant's claim 1 is reproduced for convenience:

1. A method of making an elevator belt assembly having a plurality of cords within a jacket, comprising the steps of:
  - (a) aligning the plurality of cords in a selected arrangement;
  - (b) tensioning the cords a selected amount to stretch and increase a length of the cords; and
  - (c) applying a selected jacket material comprising a substantially noncompressible urethane to the cords to encase the cords in the jacket so that the cords remain stretched within the jacket.

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Importantly, the second step of claim 1 includes stretching and *increasing a length* of the cords. Merely applying tension to a cord is not sufficient to stretch the cord. Tension must be applied at a sufficiently high level to stretch and increase a length of the cords according to Applicant's invention. There is no *prima facie* case of anticipation because the *Baranda, et al.* reference is silent regarding any stretching or lengthening of the cords in that reference.

The Examiner's position that "any degree of stretching would necessarily increase the length of the cord" is inapposite to the analysis, in part, because the *Baranda, et al.* reference never discusses stretching at all. At most, a small amount of tension is applied to hold a cord straight.

The *Baranda, et al.* reference teaches applying tension to the cords in a manner that controls the spacing of the cords from the exterior surface of the jacket that encases the cords in that reference. It is noteworthy that the *Baranda, et al.* reference is directed to a technique of making an elevator belt assembly that does not rely upon cord supports during the manufacturing process to avoid forming grooves in the exterior of the jacket. Instead of supporting the cords with a physical structure underneath the cords during a jacket application process, the *Baranda, et al.* reference teaches controlling tension on the cords to keep them straight enough to achieve a desired alignment within the jacket.

Keeping a cord straight is not the same thing as stretching and increasing a length of the cord as recited in Applicant's claims. For example, holding two ends of a cord without tension would allow the cord to sag in the middle between the two ends. Applying some tension would eventually raise the lowest point of that sag until the cords were held straight between the two ends. A sufficient amount of tension to hold the cords straight in that manner would not necessarily stretch the cords and certainly would not increase a length of the cords. There is nothing in the *Baranda, et al.* reference that in any way indicates that any of the tensions applied in that reference would cause the cords to be stretched or their lengths to increase. Tensioning the cords for maintaining them in a straight or desired alignment during a belt manufacturing process is not the same as and does not in any way suggest stretching the cords or increasing their lengths during a belt making process. It is also worth noting that the prestretching of Applicant's disclosed example in the specification results in a belt having little or no elastic stretch during elevator system operation.

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The only mentioned tension in the *Baranda, et al.* reference, by contrast, is 50 Newtons (e.g., 50 Kgm/s<sup>2</sup>). If an elevator belt would stretch so that the cords would become longer when subjected to a 50 Kg load (e.g., about 100 pounds), then that belt could not reasonably be expected to support the substantially greater weight of an elevator car, counterweight and multiple passengers in an acceptable manner. It follows that the tension applied in the *Baranda, et al.* reference does not rise anywhere near the level of a tension to prestretch a cord and increase its length as claimed by Applicant. In other words, it is not possible to find any stretching or lengthening of the cords in the *Baranda, et al.* reference.

Without an express teaching in the *Baranda, et al.* reference that the cords are stretched and their length is increased, there is no *prima facie* case of anticipation. It cannot be said that the *Baranda, et al.* reference inherently teaches what Applicant claims because the only example tension mentioned in that reference is insufficient to stretch or increase the length of a cord having sufficient weight bearing capacity for use in an elevator system.

**The rejection of claims 7-10 and 13-15 under 35 U.S.C. §102(b) as being anticipated by the PCT Patent Publication WO 01/14630 (the *Prewo* reference) must be withdrawn.**

There is no *prima facie* case of anticipation. Applicant's claim 7 is reproduced here for convenience.

7. An elevator belt assembly, comprising:
  - a plurality of cords that are stretched to an increased length; and
  - a jacket comprising a substantially noncompressible urethane over the stretched cords that keeps the cords stretched a desired amount without any external load applied to the belt assembly.

Claim 7 recites that the cords are stretched to an increased length and that the jacket over the stretched cords keeps the cords stretched without any external load applied to the belt assembly. The *Prewo* reference is silent regarding any stretching of the cords within the jacket of that reference. The only arguable mention of how the cords of the *Prewo* reference are stretched is when the reference discusses how a steel cord may break before a synthetic cord. That would only happen in the context of use of the elevator system and would require that the jacket would be stretched along with the cords if they were stretched while in use because the cords are fixed within the jacket. In other words, the only possible mentioning of anything in the *Prewo*

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reference that relates to stretching of the cords is related to breaking of the cords during use in an elevator system. It is not possible for the jacket of the *Prewo* reference to keep the cords stretched without any external load applied to the belt assembly. The only stretching (if any) mentioned in the *Prewo* reference occurs as a result of an external load (e.g., the elevator) being applied to the belt of the *Prewo* reference.

It is impossible to find any mention of a relationship between the cords and jacket in the *Prewo* reference that corresponds to having the cords stretched and the jacket keeping the cords stretched without any external load applied to the belt assembly within the *Prewo* reference. Therefore, there is no *prima facie* case of anticipation.

Claim 13 is a product by process claim and the resulting product has characteristics that are patentably distinct from the "product" of the *Prewo* reference. There is nothing in the *Prewo* reference that teaches, "the cords remain stretched within the jacket without any external load applied to the belt assembly," as recited in claim 13. In other words, the product itself is patentably distinct from the teachings of the *Prewo* reference, which only potentially has some indication of stretch in the context of an external load being applied.

**The rejection of claims 1-4, 7-9 and 11-13  
under 35 U.S.C. §102(b) as being anticipated  
by US Patent No. 1,412,310 (Lambert) must be withdrawn.**

The *Lambert* reference does not include using a noncompressible urethane material as a jacket. Instead, layers of fabric are laid between layers of cords in that reference. None of the claims are anticipated because independent claims 1, 7 and 13 each expressly recite a jacket comprising a substantially noncompressible urethane. Without that, the *Lambert* reference cannot possibly anticipate any of Applicant's claims.

**The rejection of claims 2-4, 6, 9 and 11-12  
under 35 U.S.C. §103 based upon the *Prewo* reference  
and the *Roberts* reference must be withdrawn**

There is no *prima facie* case of obviousness. Even if the proposed combination could be made, there is nothing that corresponds to or suggests stretching cords in a manner that increases

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a length of the cords as recited in Applicant's claims. The rejection must be withdrawn.

As described above, the *Prewo* reference does not provide any indication of any tension on the cords to stretch the cords to increase their length combined with applying a jacket material to the cords so that they remain stretched within the jacket. There is nothing within the *Prewo* reference regarding tensioning the cords at all. There is nothing in the *Roberts* reference that teaches stretching or increasing a length of the cords. Instead, the only tension is that reference is to hold the cords straight. Therefore, it is impossible to make the leap to the techniques recited in Applicant's claims. It is not possible to establish a *prima facie* case of obviousness based on the *Prewo* and *Roberts* references without using attributing features to them that are not there and to use improper hindsight to somehow justify finding a reason to utilize particular tension loads to achieve something that the references never discuss (e.g., prestretching cords to increase their length and applying a jacket to them).

This case should be allowed.

Respectfully submitted,  
CARLSON, GASKEY & OLDS

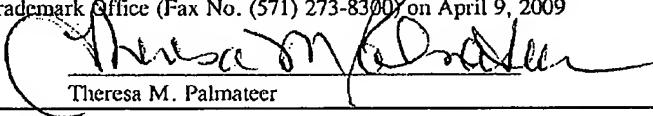
By:

  
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Dated: April 9, 2009

**CERTIFICATE OF FACSIMILE**

I hereby certify that this Pre-Appeal Request for Review relative to Application Serial No. 10/522,191, is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on April 9, 2009

  
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Theresa M. Palmateer